



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/510,458	08/15/2005	Thomas Fay-Oy Lim	LC-477/PCT/US	2280				
7590 01/16/2009								
STEVEN C. BAUMAN HENKEL CORPORATION 1001 TROUT BROOK CROSSING ROCKY HILL, CT 06067		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">ZEMEL, IRINA SOPHIA</td></tr></table>			EXAMINER		ZEMEL, IRINA SOPHIA	
EXAMINER								
ZEMEL, IRINA SOPHIA								
		<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1796</td><td></td></tr></table>			ART UNIT	PAPER NUMBER	1796	
ART UNIT	PAPER NUMBER							
1796								
		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>01/16/2009</td><td>PAPER</td></tr></table>			MAIL DATE	DELIVERY MODE	01/16/2009	PAPER
MAIL DATE	DELIVERY MODE							
01/16/2009	PAPER							

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,458	Applicant(s) LIM ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1-28-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitations appearing in claims 22 and 23, i.e., claiming aminoalkyltrimethoxy silane (or aminopropyletrimethoxysilane) lack antecedent basis in the specification. .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The clauses "said alkoxysilyl groups", "said lubricous agent", "the surfactant", "the polyether diol" in claims 1 (14, 17, 18-20, 24-25,), 4, 5 and 12, respectively, lack expressed antecedent basis.

In claims 1, 18-19 and 25 it is not clear whether "a catalyst" recited in the "provided" portion of the claim is the same or different from "a catalyst" recited in first and second parts of the composition.

In claim 1, the meaning of "a nitrogen-containing compound having an active hydrogen" is not clear insofar as what the hydrogen is "active" towards.

Claim 2 is confusing and it is not clear how it limits the compositions of claim 1 by referring to future product that can be obtained from this compositions.

In claims 7-9, "the catalyst" is recited, however it is not clear which catalyst is defined in those claims as the base claims recites "a catalyst" several times.

Claim 16 refers to foam of claim 1, however, claim 1 is drawn to a composition, not a foam.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 4,767,794 to Modic et al., (hereinafter Modic").

Modic discloses foamed compositions that are obtained via foaming compositions containing a vinyl capped polysiloxane prepolymer; a polyhydrogen

Art Unit: 1796

siloxane; a catalyst which accelerates both foaming and cross-linking through said alkoxysilyl groups; a nitrogen-containing compound having an active hydrogen (primary/secondary amines) and water. While the addition crosslinking of the vinyl polysiloxane and polyhydrogen siloxane take place via a different mechanism of alkoxysilyl condensation crosslinking, the final product obtained from compositions disclosed in the reference is believed to be substantially identical to the claimed product as the formed crosslinks are chemically the same and the product, thus, is indistinguishable from the claimed product. The burden is shifted to the applicants to provide factual evidence to the contrary.

Claim Rejections - 35 USC § 103

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Modic in combination with the applicants own disclosure.

The disclosure of Modic is discussed above. While disclosing various used for elastomeric foams of the invention (column 1), Modic. Does not expressly disclosed vibration and sound dampening compositions or composite structure having two substrates and the elastomeric between the substrates (a very common structure for insulation of dampening devices. However such use of the siloxane based elastomeric foams of Modic would have been obvious for an ordinary artisan as similar silicone foams are notoriously known for such uses, as evidence from applicants own disclosure (see page 1) and in addition it is the examiners position that such uses are well known and, thus, obvious.

Allowable Subject Matter

Claims 1-13 and 18-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

No prior art of record discloses compositions that contain all four difference components claimed in those claims, i.e. 1) alkoxy silylcapped polysiloxane prepolymer; 2) a polyhydrogen siloxane; 3) a nitrogen-containing compound having an active hydrogen (primary/secondary amines) and 4) water (either in one or two-part compositions), or their uses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

ISZ